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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/512,568	02/24/2000	Mich B. Hein	TSR1-184.2Con3	5810

30542 7590 10/21/2004

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EXAMINER

COLLINS, CYNTHIA E

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/512,568

Applicant(s)

HEIN ET AL.

Examiner

Cynthia Collins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on September 8, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28,31-38,43,50,54-63,69-77 and 79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28,31-38,43,50,54-63,69-77 and 79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

The amendment after final rejection filed September 8, 2004 has been entered.

The finality of the office action mailed July 27, 2004 is withdrawn.

Claims 1-27, 29-30, 39-42, 44-49, 51-53, 64-68, 78 and 80-106 are cancelled.

Claims 28, 31, 38 and 75 are currently amended.

Claims 28, 31-38, 43, 50, 54-63, 69-77 and 79 are pending and are examined.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

All previous objections and rejections not set forth below have been withdrawn.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 28, 31-38, 43, 50, 54-63, 69-77 and 79 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-69 of U.S.

Patent No. 6,417,429. Although the conflicting claims are not identical, they are not patentably

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distinct from each other because the patented plant cells and plant cells produced by the patented methods contain the type of nucleotide sequences that encode polypeptides that form abzymes, immunoglobulins and antigen specific immunoglobulins as claimed herein, because the nucleotide sequences encoding immunoglobulin heavy- and light-chain polypeptides contained by the patented plant cells and plant cells produced by the patented methods are known to encode the type of polypeptides that form abzymes, immunoglobulins and antigen specific immunoglobulins.

Claims 28, 31-38, 43, 50, 54-63, 69-77 and 79 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-27, 29-65 and 83-92 of copending Application No. 09/491,322. Although the conflicting claims are not identical, they are not patentably distinct from each other because the plant cells utilized by the methods claimed in copending Application No. 09/491,322 contain the type of nucleotide sequences that encode polypeptides that form abzymes, immunoglobulins and antigen specific immunoglobulins as claimed herein, because the nucleotide sequences encoding immunoglobulin heavy- and light-chain polypeptides contained by the plant cells utilized by the methods claimed in copending Application No. 09/491,322 are known to encode the type of polypeptides that form abzymes, immunoglobulins and antigen specific immunoglobulins. Further, passive immunization methods using immunoglobulins produced by conventional methods were well known in the art as of the filing dates of the instant and copending applications.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 28, 31-38, 43, 50, 54-63, 69-77 and 79 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/372,614. Although the conflicting claims are not identical, they are not patentably distinct from each other because the plant cells claimed in copending Application No. 10/372,614 contain the type of nucleotide sequences that encode polypeptides that form abzymes, immunoglobulins and antigen specific immunoglobulins as claimed herein, because the nucleotide sequences encoding immunoglobulin heavy- and light-chain polypeptides contained by the plant cells claimed in copending Application No. 10/372,614 are known to encode the type of polypeptides that form abzymes, immunoglobulins and antigen specific immunoglobulins.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Remarks

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (571) 272-0794. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (571) 272-0804. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cynthia Collins

A handwritten signature in black ink, appearing to read "Amy Nelson", with a stylized flourish at the end.

AMY J. NELSON, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600